Remarks/Arguments

Claims 21-40 are pending in this application, and are rejected in the final Office Action of May 9, 2011. No claim amendments are presented in this response. A listing of the pending claims in the application accompanies this response for the Examiner's convenience.

Re: Patentability of Claims 28 and 29 under 35 U.S.C. §112, Second Paragraph

Claims 28 and 29 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. Specifically, the Examiner alleges that the claimed "means for determining" and "means for requesting" invoke 35 U.S.C. §112, sixth paragraph, but the written description fails to disclose corresponding structure, material or acts for the claimed functions.

In response, Applicants again note that the claimed functions of the "means for determining" and "means for requesting" correspond to various steps of the control program 600 represented in the flowchart of FIG. 7 of Applicants' specification. Moreover, Applicants' specification clearly indicates that the various steps of the control program 600 represented in the flowchart of FIG. 7 "... may be executed by either the CPU 1112 of FIG. 2, the controller 115 of FIG. 4, or the ARM microprocessor 315 of FIG. 5 to implement the features according to the present invention" (see page 17, lines 3-6). Accordingly, it is clear from Applicants' specification that the claimed "means for determining" and "means for requesting" may correspond to CPU 1112 of FIG. 2, controller 115 of FIG. 4, or ARM microprocessor 315 of FIG. 5.

In view of the foregoing clarification, Applicants submit that claims 28 and 29 are definite under 35 U.S.C. §112, second paragraph, and withdrawal of the rejection is respectfully requested.

Re: Patentability of Claims 21, 23-25, 27-28, 30-32, 35 and 37-38 under 35 U.S.C. §103(a)

Claims 21, 23-25, 27-28, 30-32, 35 and 37-38 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,536,041 issued to Knudson et al.

(hereinafter, "Knudson") in view of U.S. Patent Publication No. 2003/0083533 by Gerba et al. (hereinafter, "Gerba") and U.S. Patent Publication No. 2002/0194599 by Mountain (hereinafter, "Mountain"). Applicants respectfully traverse this rejection for at least the following reasons.

Independent claim 21 recites:

> "A method for operating a television apparatus, the method comprising steps of:
> tuning a channel;
> receiving an updated program guide from a broadcaster while said channel is tuned, wherein said updated program guide is provided from said broadcaster without being requested by said television apparatus;
> in response to receiving said updated program guide, determining if a banner advertising a future program on said channel is currently displayed while said channel is tuned;
> in response to determining that said banner is currently displayed while said channel is tuned, performing a first function while said channel is tuned; and
> in response to determining that said banner is not currently displayed while said channel is tuned, performing a second function different from said first function while said channel is tuned." (emphasis added)

As indicated above, independent claim 21 recites a method for operating a television apparatus. According to the claimed method, a channel is first tuned. While the channel is tuned, the television apparatus receives an updated program guide from a broadcaster, wherein the updated program guide is provided (i.e., "pushed") from the broadcaster without being requested by the television apparatus. In response to receiving the updated program guide, the television apparatus determines if a banner advertising a future program on the channel is currently displayed while the channel is tuned. In response to determining that the banner is currently displayed while the channel is tuned, the television apparatus performs a first function while the channel is tuned. In response to determining that the banner is not currently displayed while the channel is tuned, the television apparatus performs a second function different from the first function while the channel is tuned. Independent claims 28 and 35 recite elements similar to independent claim 21.

Applicants submit that the Examiner has not presented a prima facie case of obviousness pursuant to the legal requirements of 35 U.S.C. §103.

On page 6 of the final Office Action of May 9, 2011, the Examiner addresses the aforementioned underlined element of independent claims 21, 28 and 35 as follows:

> "As to 'in response to receiving said updated program guide, determining if a banner advertising a future program on said channel is currently displayed while said channel is tuned' Knudson discloses (col. 1, lines 33-35; col. 8, line 39-col. 9, line 37) that the receiving device receives real time data (updated program guide) from the data source, which is used to display real time data on sports scores with the EPG data, where the guide continually display up-to-the-minute scores with the program listings in real time as represented in Fig. 3.
>
> Knudson meets all the limitations of the claim except 'determining if a banner advertising a future program on said channel is currently displayed while said channel is tuned.' However, Gerba discloses (¶187) that the determination is made whether the banner is displayed as represented in Fig. 32A (element 952)." (emphasis added)

As indicated above, the Examiner selectively relies on isolated elements of Knudson and Gerba for allegedly disclosing portions of the claimed element "in response to receiving said updated program guide, determining if a banner advertising a future program on said channel is currently displayed while said channel is tuned" recited by independent claim 21 (and similarly recited by independent claims 28 and 35). In particular, the Examiner ostensibly relies on the primary reference, Knudson, only for the language "in response to receiving said updated program guide", whereas Gerba is ostensibly relied upon for the language "determining if a banner ... is displayed".

In response, Applicants first submit that the Examiner has not articulated any reasons as to why one of ordinary skill in the art would be motivated to selectively combine the isolated teachings of Knudson and Gerba in the proposed manner. See *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007). Rather, the Examiner's proposed combination of Knudson and Gerba is based on mere conclusory statements (e.g., see page 6 of the final Office Action where no articulated reason for combining Knudson

and Gerba is provided). Accordingly, for this reason alone, Applicants submit that the instant rejection is deficient and should be withdrawn.

Moreover, Applicants submit that the instant rejection appears to have been formulated through a piece-meal examination, which is based on selectively picking and choosing isolated elements of various references in an effort to meet the claim language, and is clearly improper under 35 U.S.C. §103. For example, in addition to the aforementioned isolated teachings of Knudson and Gerba, the Examiner also relies on Mountain for disclosing a "banner advertising a future program" (see page 7 of the final Office Action). That is, the Examiner ostensibly relies on isolated teachings of all three cited references in an effort to meet the claim language of just a single claim element (i.e., the element "in response to receiving said updated program guide, determining if a banner advertising a future program on said channel is currently displayed while said channel is tuned" of claim 21).

Here, Applicants note that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Accordingly, the mere fact that aspects of the claimed invention may have been known, independently, in the prior art, is not sufficient to sustain an obviousness rejection.

Moreover, the mere fact that a prior art device could (in hindsight) be modified to produce a claimed invention is not a basis for an obviousness rejection unless the prior art suggests the desirability of such a modification. See, for example, *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989) ("Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to the form the [claimed] structure, '[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.'") and *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

In this case, the Examiner has not presented any evidence as to why the proposed, selective combination of isolated elements from each of the three cited references would be desirable. Rather, the proposed, selective combination of isolated elements from all three cited references in an effort to meet the claim language of just a single claim element (i.e., the element "in response to receiving said updated program guide, determining if a banner advertising a future program on said channel is currently displayed while said channel is tuned" of claim 21) strongly suggests that the instant rejection is the product of impermissible hindsight reconstruction.

Therefore, for at least the foregoing reasons, Applicants submit that claims 21, 23-25, 27-28, 30-32, 35 and 37-38 are patentable under 35 U.S.C. §103(a) over the proposed combination of Knudson, Gerba and Mountain, and withdrawal of the rejection is respectfully requested.

Re: Patentability of Claims 22, 29 and 36 under 35 U.S.C. §103(a)

Claims 22, 29 and 36 are rejected under 35 U.S.C. §103(a) as being unpatentable over Knudson in view of Gerba and Mountain, and further in view of U.S. Patent Publication No. 2004/0078817 by Horowitz et al. (hereinafter, "Horowitz"). Applicants respectfully traverse this rejection for at least the following reasons.

Horowitz is unable to remedy the deficiencies of Knudson, Gerba and Mountain pointed out above in connection with independent claims 21, 28 and 35 (from which claims 22, 29 and 36 respectively depend).

Accordingly, Applicants submit that claims 22, 29 and 36 are patentable under 35 U.S.C. §103(a) over the proposed combination of Knudson, Gerba, Mountain and Horowitz, and withdrawal of the rejection is respectfully requested.

Re: Patentability of Claims 26, 33-34 and 39-40 under 35 U.S.C. §103(a)

Claims 26, 33-34 and 39-40 are rejected under 35 U.S.C. §103(a) as being unpatentable over Knudson in view of Mountain, Gerba and Horowitz, and further in

view of U.S. Patent No. 6,396,531 issued to Gerszberg (hereinafter, "Gerszberg"). Applicants respectfully traverse this rejection for at least the following reasons.

Gerszberg is unable to remedy the deficiencies of Knudson, Mountain, Gerba and Horowitz pointed out above in connection with independent claims 21, 28 and 35, and dependent claims 22, 29 and 36 (from which claims 26, 33-34 and 39-40 ultimately depend).

Accordingly, Applicants submit that claims 26, 33-34 and 39-40 are patentable under 35 U.S.C. §103(a) over the proposed combination of Knudson, Mountain, Gerba, Horowitz and Gerszberg, and withdrawal of the rejection is respectfully requested.

Conclusion

For at least the foregoing reasons, it is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intention to concede any issue with regard to any claim, except as specifically stated in this paper.

In view of the foregoing remarks/arguments, the Applicants believe this application stands in condition for allowance. Accordingly, reconsideration and allowance are respectfully solicited. If, however, the Examiner is of the opinion that such action cannot be taken, the Examiner is invited to contact the Applicants' attorney at (609) 734-6813, so that a mutually convenient date and time for a telephonic interview may be scheduled. No fee is believed due from this response. However, if a fee is due, please charge the fee to Deposit Account No. 07-0832.

Respectfully submitted,

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